

REMARKS

Examiner Hendricks is thanked for the telephone interview with Applicants' attorney on May 18, 2005. In addition to the information in the Examiner's Interview Summary mailed May 23, 2005, the following is noted regarding the interview. While all of the pending claims were discussed in general, claims 1, 51, 53, 56, 65 and 67 were discussed specifically, and claims 8-10, 18-21, 51-56 and 68 were discussed as a group. U.S. Design Patent No. 271,344 (Faust) and U.S. Patent No. 1,855,145 (Jones) were discussed. It was agreed that the rejection of claim 56 as not further limiting claim 51 had been withdrawn. It was also agreed that claims 8, 10, 18-21 and 51-56 were patentable over the prior art. While the Examiner tended to agree with several of the arguments made during the interview, no other agreement was reached. The thrust of the arguments presented during the interview are repeated in the remarks below.

One other item that was discussed during the interview was the fact that the outstanding Office Action contained a final rejection. During the interview the Examiner suggested that this case may not yet be ripe for appeal. Therefore, possible procedures were discussed that Applicants might use to file the equivalent of a Continued Prosecution Application (CPA) without losing the benefit of the fact that the present application was filed prior to the 1995 change in patent law affecting patent term. Under the present circumstances, Applicants cannot file a continuing application without losing nearly 10 years of patent term. Further, in researching the matter, 35 C.F.R. § 1.129(a), which would normally apply to this case, appears to be unavailable since an appeal brief was previously filed in November 1995. If the following remarks are not deemed to put the case in condition for allowance, Applicants would appreciate learning of any procedure of which the Examiner is aware that might be used to reopen prosecution, because they might then wish to file amendments that they could be sure would be entered. Alternatively, the Examiner is invited to remove the finality of the outstanding Office Action.

In the Office Action Summary and on page 2 of the outstanding Office Action, the restricted and withdrawn claims are listed as 7, 11-14, 16, 17 and 22-27. Applicants

previously noted that in the Office Action mailed May 29, 2002, claim 22 was not withdrawn, that claim 22 was rejected on page 2 in that Office Action, and Applicants had argued that claim 22 is currently under consideration. In the current Office Action the Examiner indicated that because claim 22 is dependent on claim 16, and claim 16 is withdrawn, claim 22 must also have been withdrawn. However, claim 22 is directed to a chewing gum product wherein a plurality of ropes are laid in a direction generally transverse to the length of the continuous slab. Thus claim 22 is directed to the same subject matter as the species currently under examination. Hence it is still believed that claim 22 should not be withdrawn. Reconsideration is respectfully requested.

In the outstanding Office Action, claims 1-6, 8-10, 15, 18-21, 28, 51-56 and 65-68 were rejected under 35 U.S.C. § 112, second paragraph. This rejection is respectfully traversed. First, claim 53 does further limit claim 51. Even though claim 51, in its preamble, is directed to a multi-colored, sheeted chewing gum product, and the claim requires a first chewing gum and a second confectionary material, there is nothing in claim 51 that requires the second confectionary material to be a different color than the first chewing gum, which is what claim 53 requires. On page 3 of the Office Action it is stated, "the claim requires that the second gum be distinguishable from the second gum, and therefore it would inherently be of a different color." Even if this sentence was supposed to say that claim 51 requires the second confectionery material be distinguishable from the first chewing gum, there is no such requirement in claim 51. Further, even if it is distinguishable, that does not mean that it must necessarily be of a different color. The preamble of claim 51 could be met if first chewing gum itself were multi-colored, or the second confectionary could be the same color as the first chewing gum, but a third material of a different color could be present, making the overall product multi-colored. Since claim 51 could read on products where the first chewing gum and second confectionary material are the same color, claim 53, requiring them to be different colors, does further limit claim 51.

The Office Action argues that nothing in the specification shows the first and second gums are the same color, or the first gum can be multicolored, and thus argues that claim 51 cannot encompass such an embodiment. This logic is faulty. Even if there is no suggestion in the specification of these embodiments, that does not mean

that claim 51 could not cover them. There is no requirement that every embodiment within the scope of the claims be articulated in the specification. All that section 112 second paragraph requires is that the claims be specific and understandable to one of ordinary skill in the art. Since claim 51 could cover the embodiments described above, and claim 53 would not, claim 53 does further limit claim 51, and is appropriately dependent thereon.

The term “generally” in claims 1, 15, 18, 20, 21 and 67, and the term “generally perpendicular” in claim 65 does not make those claims indefinite. MPEP § 2173.05(b) sets forth that words of relative terminology are acceptable if one of ordinary skill in the art would understand what is claimed in light of the specification. In claims 1, 15 18, 20 and 21, the word “generally” modifies “flat sheet,” “flat surface” and “undulating pattern.” Page 8 of the specification states that in Figure 8 the first mass of chewing gum is formed into a slab 81 with a generally flat top surface, and then gives example methods of making such a “generally flat top surface.” One of ordinary skill in the art, referring to Figure 8 and the type of operations described on page 8, would easily be able to understand what “generally flat” means. In the art of chewing gum, it is very difficult to get something exactly flat, but if someone of ordinary skill looked at slab 81 in Figure 8, they would easily recognize it as generally flat. Especially if the second mass that is embedded in the first mass had a different elastic property than the first mass, even if a flat surface were used to compress the second mass into the first mass, after that compressive force were removed the tendency of the first and second mass to rebound may be different, meaning that the resulting surface would be “generally flat” and not exactly flat. Likewise, a person of ordinary skill in the art would be able to tell what was meant by “generally flat sheet”, “generally undulating pattern” and “generally perpendicular” as those phrases are used in the claims.

It is further noted that the same claim terms are used in U.S. Patent No. 5,538,742, which issued from a divisional application of this case. The claims in that patent have the following terms:

Claim 1: generally flat surface; generally flat sheet; (see also claims 6, 7, 12, 15, 20, 21, 24 and 29);

Claim 3: in a direction generally diagonal;

Claim 4: generally undulating pattern; (see also claim 18);
Claim 8: in a direction generally transverse to the length; (see also claim 22);
Claim 10: generally uniform size;
Claim 17: in a direction generally parallel to the length;
Claim 23: laid generally diagonally across;
Claim 31: generally uniform shape and size.

Of course the '742 patent has the same specification as the present case. Thus, the fact that the '742 patent issued with all of these claims containing the word "generally" is convincing evidence that the word "generally" used in the same way in the present claims, supported by the same specification, does not make those claims indefinite.

The Office Action, on page 4, takes the position that in the '742 patent, the terms "generally" were acceptable because "their use was not deemed [to] determine the patentability of the claimed apparatus. The instant claims are different and therefore, until applicants state on the record that the shapes are not a patentable distinction over the prior art, they are found to be indefinite." While this argument is believed to be flawed, for the record it is agreed that Faust shows generally flat surfaces on the chunk of chewing gum depicted. To that extent, the claimed shape is not a patentable distinction. Regardless of that, however, just as in the '742 patent, the term "generally" does not make claims 1, 15, 18, 20, 21, 65 and 67 indefinite. This rejection should therefore be withdrawn.

In the outstanding Office Action, claims 1, 2, 4, 5, 15, 65, 67 and 68 were rejected under 35 U.S.C. § 102 as anticipated by U.S. Design Patent No. 271,344 (Faust). This rejection is respectfully transversed. Faust discloses a two color chewing gum. There is no disclosure as to the make-up of the composition of the different parts of the product. However, a person of ordinary skill would assume that the darkly shaded areas of the product are made of the same material since they are similarly shaded. Claim 1 calls for the second mass to be embedded in the first mass so as to be visible with the first mass from the top surface of the product, but the first mass only is visible from the bottom surface. Faust does not meet this limitation. In Faust, the description states that the rear perspective view and bottom view are, respectively, mirror images of the front perspective and top views shown. Hence the second color of

chewing gum would be viewable from both the top and bottom surfaces, and both side surfaces. If an end surface is taken to be the top, then the "bottom" would be identical and show both colors. No matter which side is considered to be the top, the bottom will have both colors of chewing gum present.

The outstanding Office Action takes the position that the top dark mass is considered to be the second mass, and the bottom dark mass is considered to be a third mass. Hence, according to this interpretation, the second mass is not viewable from the bottom. It is clear from the present specification that the term "second mass" means a composition, but is not necessarily contiguous. During the interview, while discussing claim 68, the Examiner questioned how the second mass could constitute a plurality of stripes. It was explained that in the specification the term "second mass" referred to a confectionary material that had a common composition (including color), not necessarily a contiguous material. For example, one page 2, lines 15-17, it states, "A second mass of a confectionary material is formed into at least one piece which is brought into contact with a generally flat sheet." Thus the second mass may clearly be multiple pieces as well as one piece, but the multiple pieces would have a common composition. Later, in the paragraph bridging pages 8 and 9, it is explained that one composition of a second mass can be applied to the first mass in separate ropes all made from the same composition. In that instance, even though there are multiple sections of this second composition, they are all referred to as being the second mass. Numerous other places in the specification use the term "second mass" in this same way. Thus, as interpreted in light of the present specification, the term "second mass" must be interpreted to mean all confectionery material in the product which has the same composition (different of course from the first mass), regardless of whether that confectionery material were present in one contiguous form or separated into different sections. Of course, the fact that different pieces of the second mass all have the same composition does not preclude the fact that some embodiments of products of the present invention may have additional compositions included. For example, page 7 lines 10-11 describe an embodiment where additional bits of confectionary of different colors and flavors may be included in a product along with the second mass bits.

When properly construed, claim 1 thus distinguishes over Faust in this regard. As noted above, Faust does not state that the top dark mass is different than the bottom dark mass. Nor is there anything that would make this inherent in Faust. On the contrary, since the specification states that Faust discloses a two color chewing gum, the top and bottom dark masses are at least the same color. Furthermore, a person of ordinary skill would presume that they had the same composition. Certainly there is nothing in Faust that inherently requires the top and bottom dark masses to have different compositions. Therefore, as the claim is interpreted in view of the specification, the top and bottom dark material in Faust would both be considered to be parts of the second mass. Since Faust clearly has something other than the first mass visible from the bottom surface, Faust does not anticipate claim 1.

There are several other differences between Faust and claim 1. Perhaps most important for the present invention is that Faust does not disclose the first mass of chewing gum being formed into a sheet. Applicants took the position that Faust discloses a chunk of gum, rather than a sheet. The Office Action states that "It is not clear how applicants determined that [Faust discloses] a chunk". This is readily apparent from simply looking at the relative dimensions of the product disclosed in Faust, and comparing that to the sheet products disclosed in the present specification. In a sheet, one dimension is thin compared to its other dimensions, such as in a stick of gum or a rolled up tape product disclosed in the present specification. In the depicted Faust product, the smallest dimension is over 50% as thick as the next smallest dimension, and still over 40% of the largest dimension. There is not one dimension that is thin compared to the other two dimensions.

Furthermore, other than questioning Applicants' description, the Examiner has given no support for the position that the shape shown in Faust would be considered a sheet by one of ordinary skill in the art. Finally, this issue was already raised in this case and previously decided in Applicants' favor. The Board of Appeals has construed the term "sheet" in claim 1 to mean something other than what is shown in a prior art reference that is very similar in shape to Faust. See Decision of Board of Appeals mailed May 17, 2000, page 6, where it is stated that the square gum sections shown in Towae were not flat sheets. The same is true with Faust. The Examiner has not

provided any evidence that the chunk of gum disclosed in Faust is considered in the art to be a sheet.

Claim 1 also requires that the second mass is present in a pattern selected from the group consisting of an undulating pattern, a pattern of stripes across a width of the product, a diagonal pattern, a pattern of bits, and combinations of the foregoing. Faust does not disclose any of these patterns, and especially not a pattern of stripes across a width of the product, which is the portion of the Markush group presently under consideration. Faust discloses two portions of a second mass going in the same direction as the length of the chunk. While it may be argued that the height and width of the product in Faust can easily be changed by rotating the product, the length of a rectangular solid is always considered to be its longest dimension. Thus the width has to be one of the other two dimensions, and the two portions of the second mass are not stripes across either of these two shorter dimensions. Further, the Examiner's position that the bottom dark mass is a third mass would mean that there is only one stripe of the second mass in Faust, so if this interpretation of the prior art is taken, the second mass in Faust is not in the form of a plurality of stripes. For all of these reasons, claim 1 is not anticipated by Faust.

Claim 67 has many of the same limitations as claim 1. For example, claim 67 states that the second mass is not visible from the bottom surface of the product. As explained above, a correct interpretation of Faust is that both the top and bottom dark areas are part of the second mass. Therefore the second mass is visible from the bottom in Faust. Claim 67 also requires that the first mass be in the form of a sheet. As explained above, Faust does not disclose a first mass in the form of a sheet. Thus claim 67 is not anticipated by Faust.

Claims 2, 4, 5, 65 and 68 are dependent on claims 1 and 67, and thus also differ from Faust in the same manner as discussed above. In addition, claim 68 specifically requires the second mass to be present in a pattern of stripes across the width of the product, which as discussed with respect to claim 1 is not found in Faust. Claims 5 and 65 require that the first mass is formed into an elongated strip. Faust does not disclose an elongated strip, and claims 5 and 65 are patentable for this further reason. Claim 65 requires that the stripes of the second mass are generally perpendicular to the direction

of elongation of the strip. Faust clearly does not teach this feature. Claim 65 is thus further patentable over Faust.

Claim 15 includes two sets of limitations, the product limitations from claim 1 and the process limitations explicitly recited in claim 15. Since claim 1 is patentable over Faust, claim 15 is also patentable over Faust for at least the same reasons. MPEP 2173.05 (p) indicates that product-by-process claims may be utilized to present claims of varying scope. This inherently requires that the process limitations be given patentable weight. While claim 15 has been shown to be patentable over Faust irregardless of the process limitations, it is also clear that the product of Faust would not suggest the steps of bringing at least one piece of a second mass of confectionary product into contact with a flat surface of a slab of chewing gum and pressing the slab to form a generally flat sheet with the second mass embedded in it, as required by claim 15. Hence claim 15 is not anticipated by Faust for this further reason.

In the outstanding Office Action, claims 3, 6, 9, 28 and 66 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. Des. 271,344 (Faust) in view of U.S. Patent No. 1,855,145 (Jones) and further in view of the "Bubble Tape" and "Fruit Stripes" products referred to on page 1 of the specification. This rejection is respectfully traversed.

The Office Action takes the position that Faust discloses two layer chewing gums with one embedded in the other so that the top layer is not viewable from the bottom. Claims 3, 6, 9, 28 and 66 are all dependent on claim 1. As noted above, claim 1 requires the second mass to be embedded in the first mass so as to be visible with the first mass from the top surface of the product, but the first mass only is visible from the bottom surface. Also as noted above, Faust does not meet this limitation. No matter which side is considered to be the top, the bottom will have both colors of chewing gum present.

Jones discloses an edible article such as a candy bar. The form of the product, and the use of two different materials to make it, is such that the eater is compelled to automatically partake of the product such that each bite has a different composition than the previous bite, thus overcoming the problem that the sense of taste becomes saturated in a small amount of time, and the last bite of a candy bar does not taste as

good as the first. Figure 10 of Jones discloses a bar having a constant proportion of one material formed as a base upon which is placed a bar having a progressively changing composition.

Jones would not suggest to one of ordinary skill in the art to modify the chewing gum product of Faust to come up with the claimed invention. First, the Jones idea would not even be applicable to chewing gum, which is not swallowed bite after bite as would be the product in Jones. Since the two-color chewing gum product of Faust would normally be placed in the mouth all at once, and chewed over a period of time, there would be no advantage to putting one color of chewing gum in the form of a stripe so that each bite has a different composition. Second, the product of Faust is a chunk of gum, rather than a bar product as used in Jones. Third, chewing gum is quite different than the candy bar, cake and ices disclosed in Jones, therefore it would not have been obvious to apply the teachings of Jones to the Faust product.

The Office Action argues that "Merely because cake confections are different from gum confections does not eliminate the obviousness of their combined teachings. Both technologies stem from the confection art." This argument fails to appreciate that the two products are consumed in completely different ways. Chewing gum is by definition designed to have a portion that stays in the mouth as the product is chewed. As a result, serving sizes of chewing gum of the type disclosed in Faust are provided so that they are placed in the mouth all at once, rather than bitten off and swallowed in steps as are the candy bars of Jones. Thus the suggested motivation to combine the teachings of the references so that as a consumer bites the gum a changed composition is encountered has no basis in reality.

The Bubble Tape and Fruit Stripes products do not make the invention of claim 1 obvious. Bubble Tape does not include multiple components, so the concept of a pattern on one side and no pattern from the bottom could not be suggested by the product. Furthermore, one would not combine Faust and Bubble Tape to produce an elongated, flattened version of the design of Faust, since in so doing the design of Faust, which is intended to be a finished product, would be distorted. Furthermore, the product would have both colors showing on both the top and bottom surfaces, which as discussed above is opposite to the requirements of claim 1. Fruit Stripes has a stripe

that shows on both sides. Thus any motivation to make a product with diagonal stripes would also be a motivation to make a product with stripes on both sides. Only Figure 10 of Jones is a product with one composition entirely making up a base and two compositions making up a top surface. However, while such a product could be readily formed using a chocolate base, it would not be obvious even from Jones of how to make such a product where the first mass is chewing gum. If one wanted to follow the teachings of Jones and make a chewing gum product, at best the product would be like the other embodiments in Jones, where both colors are apparent from both sides. It would not have been obvious to make a product like Fig. 10 of Jones using the chewing gum of Faust.

The previous Office Action further states that there would be motivation from Jones to modify an elongated rolled up tape product so that "a changed composition is encountered". However, the product in Jones was made of two different compositions that tasted differently. The product of Faust at most has two different colors. There is no suggestion that two different compositions be used that taste differently. Thus, even if someone were to make the product of Faust into an elongated rolled up tape, since both compositions would taste the same, the idea behind Jones of varying the amount of one composition compared to the other in each bite would not even be applicable. Hence there would be no motivation to modify the elongated tape to have different colors present in different amounts at different longitudinal positions along the tape.

The Office Action cites *In re Levin*, 84 U.S.P.Q. 232 as supporting the rejection. However, that case is not applicable to the present claims. Levin deals with a new recipe or formula for cooking food. The present claims deal with a structure and configuration of an edible material, not the recipe or formula for making the individual first and second masses.

Since it would not have been obvious from the cited references to come up with the invention of claim 1, claims 3, 6, 9, 28 and 66 dependent thereon are patentable over the cited references. Claim 28 is dependent on claim 15, and like claim 15 is patentable over Faust for additional reasons. None of the secondary references suggest the method steps required by claim 15, and hence of claim 28, let alone the further method steps of not using a rolling compound between the first mass of chewing

gum and the second mass of confectionary material so that the two are not separable by the consumer, as called for in claim 28. Thus claim 28 is further patentable over the cited references.

Since each of the rejections has been overcome, the case is in condition for allowance.

Respectfully submitted,

/Steven P. Shurtz/
Steven P. Shurtz
Registration No. 31,424
Attorney for Applicants

BRINKS HOFER GILSON & LIONE
P.O. BOX 10395
CHICAGO, ILLINOIS 60610
(312) 321-4200
Direct Dial (801) 444-3933